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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,164	08/28/2001	Amit Patel	967.060US1	4647

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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/03/2003

61

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/941,164

Applicant(s)

PATEL ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 27, 2003 and January 7, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 27, 2003 has been entered in Paper No. 9.

This Office Action is a response to Applicant's request for continued examination (RCE) filed March 27, 2003 in Paper No. 9, and amendment and response to the Final Office Action (mailed October 1, 2002), filed January 7, 2003 in Paper No. 7 wherein claims 1-5, and 7 have been amended, and claims 13-19 are newly submitted. However, claims 13-21 as originally filed are cancelled in Paper No. 5.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Since applicant has two set of claims 13-19 originally presented and claims 13-19 now newly submitted, the claims herein have been renumbered in accordance with Rule 126 and the dependency of renumbered dependent claims has been completely

changed as well. Thus, the new claims herein are now numbered 22-28 instead of 13-19. Currently, claims 1-12 and 22-28 are pending in this application.

Claims 1-12 and 22-28 are examined on the merits herein.

Applicant's remarks filed January 7, 2003 in Paper No. 7 with respect to the rejection of claims 1-12 made under 35 U.S.C. 112 first paragraph for containing new subject matter of record in the Office Action dated October 1, 2002 have been fully considered and found persuasive to remove the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 8, 10-12, and 22-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment adding the recitation "a first aqueous phase" with respect to amended claims 1-5, 8, 10-12, and new claims 22-28 filed January 7, 2003 in Paper No. 7 has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for the recitation, "a first

aqueous phase" comprising the specific ingredients herein. The original specification and claims do not teach "a first aqueous phase", but merely discloses that for example "The water phase is added to the oil phase to form an emulsion" (see page 3 line 16-17 of specification herein). One of ordinary skill in the art would recognize that an emulsion would not be a first aqueous phase. Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8, 10-12, and 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "a first aqueous phase" renders claims 1-5, 8, 10-12, and 22-28 indefinite. The recitation "a first aqueous phase" is not defined in the specification. Therefore, one of ordinary skill in the art could not interpret as to what would be considered to be "a first aqueous phase".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (6,221,345, of record), Palinczar (4,724,139, of record), and Kasat et al. (5,424,070 , of record) in view of Bonastre Gilabert et al. (WO 2000001875, PTO-892) and Kropf et al. (WO 2000047177, PTO-892).

Esser discloses that glycery stearate, dicapryl ether, cetearyl alcohol, Ceteareth-20, and water, and antiperspirant such as aluminum chlorohydrate are useful in antiperspirant deodorant compositions. See abstract, col.4-5 Example 1-5, col.11 Example 11-12 and claims 1-2.

Palinczar discloses that glycery stearate, cetyl palmitate, fatty alcohols and antiperspirant such as aluminum chlorohydrates are useful in antiperspirant deodorant compositions. See abstract, col.4 lines 55-64, col.5 lines 5-15.

Kasat et al. discloses that Eumulgin compounds such as Ceteareth-12 and Ceteareth-20, and antiperspirant are useful in antiperspirant deodorant compositions. See abstract, col.4 lines 50-64.

The prior art does not expressly disclose the employment of the combination of glyceryl stearate, ceteareth-20, cetyl palmitate, cetearl alcohol, ceteareth-12, dicapryl

Art Unit: 1617

ether, caprate, cetearyl alcohol, and water, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositions.

Bonastre Gilabert et al. teaches the employment of the the employment of the combination of glyceryl stearate, ceteareth-20, cetyl palmitate, cetearyl alcohol, dicapryl ether, caprate, cetearyl alcohol, and water in a cosmetic composition.

Kropf et al. the employment of the combination of glyceryl stearate, ceteareth-12, cetyl palmitate, cetearyl alcohol, dicapryl ether, caprate, cetearyl alcohol, and water,

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the combination of glyceryl stearate, ceteareth-20, cetyl palmitate, cetearyl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and water, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositions.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the combination of glyceryl stearate, ceteareth-20, cetyl palmitate, cetearyl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and water, and antiperspirant such as aluminum chlorohydrate in antiperspirant deodorant compositionssince each of these components is known to be useful in antiperspirant deodorant compositions based on the prior art. Moreover, the combination of glyceryl stearate, ceteareth-20, cetyl palmitate, cetearyl alcohol, ceteareth-12, dicapryl ether, caprate, cetearyl alcohol, and water is known to be useful in cosmetic compositions. Therefore, one of ordinary skill in the art would have reasonably expected that

combining each of these components would improve the property and/or usefulness of antiperspirant deodorant compositions.

Since all active composition components herein are known to useful in antiperspirant deodorant compositions, it is considered prima facie obvious to combine them into a single composition to form a third composition useful for the very same purpose. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

Applicant's remarks filed January 7, 2003 in Paper No. 7 with respect to the rejection of claims 1-12 made under 35 U.S.C. 103(a) in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

First, Applicant argues that none of the references cited describes a formulation having the physical and chemical properties in claims 6, and 7-12. However, the physical and chemical properties of a formulation are not considered to be a limitation to a formulation or a composition since it is well settled that recitation of an inherent property of a composition or a formulation will not further limit claims drawn to a composition or a formulation.

Applicants argument that the Kasat reference is not aqueous, is not found convincing. However, as Applicant admits, the Esser patent teaches a creamy aqueous emulsion. Moreover, the instant claimed products are not directed to an aqueous

solution. Further, the agents herein in the oil phase are known to be useful in antiperspirant deodorant compositions according the cited prior art herein.

As discussed in the previous Office Action (October, 1, 2002) one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In *re Keller*, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In *re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145. More importantly, it has been held that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose in order to form a third composition that is to be used for the very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06.

In the instant case, as discussed above and in the previous Office Action, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

The record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
May 20, 2003